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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/606,742	06/29/2000	Dr. James L. Cox	086-C1	7780
7590	09/21/2004		EXAMINER	
JENS E. HOEKENDIJK HOEKENDIJK & LYNCH, LLP P.O. BOX 4787 BURLINGAME, CA 94011-4787			ISABELLA, DAVID J	
			ART UNIT	PAPER NUMBER
			3738	

DATE MAILED: 09/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/606,742	COX ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	DAVID J ISABELLA	3738	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 19 May 2004.

2a)  This action is **FINAL**.                    2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

4)  Claim(s) 26,28,30-46,52-67,69,71-73 and 76-89 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 26,28,30-46,52-67,69,71-73 and 76-89 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All    b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.  
5)  Notice of Informal Patent Application (PTO-152)  
6)  Other: \_\_\_\_\_.  
\_\_\_\_\_

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 26,28,30-46,4,52-67,69,71-73,76-89 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moll, et al (5309896) in view of Swartz et al (5575766).**

Moll, et al discloses a method for retracting an organ inside the body in the course of treating adjacent tissue. Moll, et al teaches a procedure in which a small, oblate version of a Type I or Type II retraction device is used to displace the pericardium 403 from the heart 408 is shown in FIG. 15, which shows a transverse cross section of the chest. Displacement of the pericardium allows the outer surface 413 of the heart 408 to be observed, and such procedures as endocardial mapping, ablation, transmyocardial revascularization, and defibrillation to be carried out. These procedures have until now been difficult to do laparoscopically because access to the surface of the heart 408 is obstructed by the pericardium 403. Moll, et al is not specific to the particulars concerning the actual ablating procedures. Swartz, et al disclose ablation and mapping devices and procedure for forming a lesion extending from the pulmonary vein to the annulus of the mitral valve. To use a device/method similar to that as taught by Swartz, et al in combination with the retraction method of Moll, et al would have been obvious to one with ordinary skill in the art in order to avoid more costly surgical intervention and trauma. The combination of the references would yield a method for

forming a lesion in heart tissue of a patient including providing an ablating device, creating an opening in the patient's chest, the opening passing through the chest wall and into the patient's thoracic cavity; pass the electrode through the opening; positioning the electrode adjacent the heart tissue and ablating the heart tissue.

Claims 27-35, 43-47, 71-78 the surgical steps for forming the lesions is taught by Swartz ,et al. (columns 10,11 and 13)

Claim 51, the elongate ablating element of Swartz, et al is malleable.

**Claims 49,52-67,69,82-89 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moll, et al as modified by the secondary references and as applied to claim 26 above, and further in view of Edwards (5569241).**

An ablation device having means for measuring temperature of a wall of the heart opposite the elongate ablating portion is taught by Edwards. (column 6, lines 20+ and column 10, lines 54+) The use of a different shaped ablation device, including one with means for clamping tissues in place or in addition to the combination of Moll et al would have been obvious to one with ordinary skill in the art based on surgical considerations. The dependent claims are merely repetitive of the dependent claims of the previous set dependent from claim 26 and the rejections to the corresponding claims are fully met as applied with respect to claim set 26.

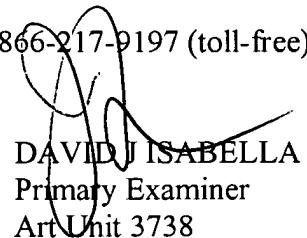
**Claims 36,37,57,58,79 and 80 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moll,et al in view of Swartz, et al (5575766) or Edwards (5569241) as applied to the corresponding claims above, and further in view Jones .(428224).**

Moll,et al is not specific to the particulars concerning the actual ablating procedures and Jones teaches forming a seal in a tissue about a cannula with the use of a purse-string suture. To form a seal in the heart tissue about the ablation tool of Moll, et al as modified to control bleeding from the organ during the procedure based on surgical considerations without departing from the scope of the surgical method of ablating targeted heart tissues would have been obvious to one with ordinary skill in the art from the teachings of Jones..

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DAVID J ISABELLA whose telephone number is 703-308-3060. The examiner can normally be reached on MONDAY-FRIDAY.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, CORRINE MCDERMOTT can be reached on 703-308-2111. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



DAVID J ISABELLA  
Primary Examiner  
Art Unit 3738

DJI  
SEPTEMBER 21, 2004